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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Phase Forward Incorporated

v.

Mary Noel Adams

Opposition No. 91156778
to Serial No. 78169672

David J. Shannon and M. Kelly Tillery of Leonard Tillery & Sciolla, LLP for Phase Forward Incorporated.

Matthew W. Stavish of Liniak Berenato & White, LLC for Mary Noel Adams.

Before Seeherman, Bucher and Grendel, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Mary Noel Adams seeks registration on the Principal Register of the mark PHASE FORWARD (standard character drawing) for services recited in the application as "consultation services in the fields of product management, marketing and business planning," in International Class 35.¹

Registration has been opposed by Phase Forward Incorporated. As its grounds for opposition, opposer

¹ Application Serial No. 78169672 was filed on October 1, 2002 based upon applicant's allegation of first use anywhere and first use in commerce at least as early as September 20, 2002.

asserts that applicant's mark when used in connection with applicant's services so resembles opposer's previously used and registered marks, as well as its "family" of marks, as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act, and furthermore, that should applicant be issued a registration, it is likely to injure opposer's business reputation and dilute the distinctive quality of opposer's famous trade name and registered marks under Section 43(c) of the Trademark Act.

Applicant, in her answer, has denied the salient allegations in the opposition.

The Record

By operation of the rules, the record includes the pleadings and the file of the opposed application. Opposer has also made of record its pleaded registrations by submitting certified status and title copies of the following three registrations:

REGISTRATION NO. 2366760 **PHASE FORWARD** (STANDARD CHARACTER DRAWING)
for "computer software used in the management of clinical trials
of pharmaceutical products and medical devices and management
of data resulting therefrom" in International Class 9;²

² Registration No. 2366760 issued on July 11, 2000 claiming first use anywhere at least as early as June 3, 1997 and first use in commerce at least as early as December 14, 1998.

REGISTRATION No. 2580055



PHASEFORWARD

for "clinical data collection in the field of clinical and medical trial management and management services related to human clinical trials" in International Class 42;³ and

REGISTRATION No. 2599003



PHASEFORWARD

for "computer software used in the management of clinical trials of pharmaceutical products and medical devices and management of data resulting therefrom" in International Class 9.⁴

Opposer has also made of record, pursuant to a notice of reliance, applicant's responses to opposer's first set of interrogatories; the discovery deposition, with the relevant exhibits, of Mary Noel Adams, the applicant herein; and a decision by the National Arbitration Forum in a domain name dispute involving the parties herein.

The parties have fully briefed the case, but an oral hearing was not requested.

Preliminary matters

Opposer also submitted a number of additional materials under its notice of reliance. However, for various reasons, these materials cannot be made of record in this fashion,

³ Registration No. 2580055 issued on June 11, 2002 claiming first use anywhere and first use in commerce at least as early as August 15, 2000.

⁴ Registration No. 2599003 issued on July 23, 2002 claiming first use anywhere and first use in commerce at least as early as May 2001.

and therefore they have not been considered. They include opposer's own responses to applicant's first set of interrogatories. Under the circumstances of this case (where applicant has submitted no evidence during its testimony period), an answer to an interrogatory may be submitted and made part of the record by only the inquiring party. 37 CFR §2.120(j)(3)(i)(5). Similarly, opposer may not rely on the discovery deposition of its own corporate counsel, which was taken by applicant. 37 CFR §2.120(j)(1).

Opposer submitted the pleadings from a domain name dispute between the parties, but these documents do not qualify as official records under 37 CFR §2.122(e). As to the affidavits of Christopher D. Olsyk, Jr., and Lynette H. Rezac, affidavits cannot be submitted unless the parties have stipulated to this, and no such stipulations have been filed. 37 CFR §2.123(b). Furthermore, as to the results of Mr. Olsyk's Internet search, printouts from Internet web searches cannot be submitted by a notice of reliance as they do not qualify as printed publications under 37 CFR §2.122(e). See In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999). See also Raccioppi v. Apogee Inc., 47 USPQ2d 1368 (TTAB 1998) and TBMP Section 708. Finally, correspondence between opposer's counsel and applicant's counsel does not fall within any of the enumerated

categories of evidence appropriately submitted under a notice of reliance.

The Facts

Because so much of the material submitted by opposer was not properly made of record, the only information we have about opposer is that it is the owner of its three pleaded registrations and, because Ms. Adams testified in her discovery deposition that she visited opposer's website, we know that opposer has a website.

Applicant adopted the mark PHASE FORWARD during August 2002 and has been in the consulting business as a sole proprietor since October 2002. Applicant conducts her business primarily in California, but promotes her mark, *inter alia*, in Illinois, Maryland and Texas. Applicant's response to Interrogatory No. 2. Applicant also advertises and conducts business over the Internet. Adams Deposition, pp. 33-35. Consistent with the recital of services in the involved application, the evidence of record demonstrates that applicant provides consultation services in the fields of product management, marketing and business planning. In conjunction with Blue Mug, a Berkeley, California software company, applicant has strategized about the ways in which health care facilities would develop wireless software

applications to run on handheld devices and wireless phones. Moreover, applicant has expressed her interest in teaming up with a health care consultancy firm to equip hospitals with a "Wireless Fidelity" (Wi-Fi) infrastructure, allowing the use of personal digital assistants (PDAs) for tasks such as electronic data capture. In correspondence of record, she listed nurses, doctors, administration and other healthcare staff as potential users of these wireless software, devices and services. Adams Deposition, pp. 63-93, Bates Nos. Adams 214, 217, 204, 405-408, and 484. Applicant testified that in 2003 her website did list as clients or partners entities such as McKesson Corporation (provider of healthcare supply, information and care management products) and Aether Systems (mobile and wireless data solution provider).

Our Analysis

- **Standing**

As a preliminary matter, we find that opposer has established its standing in view of its registrations of the term PHASE FORWARD.

- **Priority**

Because opposer has made of record valid and subsisting registrations of its pleaded registrations, the issue of priority does not arise. See King Candy Company v. Eunice

King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995).

- **Likelihood of Confusion**

We turn then to the issue of likelihood of confusion. Although opposer has pleaded ownership of a family of marks in its notice of opposition, and has referred to such a family throughout its briefs, opposer has not demonstrated that it has promoted any of its marks together, such that they would be considered a family. See J & J Snackfoods Corp. v. McDonald's Corp., 932 F.2d 1360, 18 USPQ2d 1889 (Fed. Cir. 1991). Therefore, we must determine the issue of likelihood of confusion with respect to the three individual marks that are the subject of opposer's registrations.

Our determination of likelihood of confusion must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the

services and/or goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn then to the du Pont factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. In this case, as to opposer's first cited registration, the marks of the parties are identical in sound and appearance.

As to opposer's two design marks, the literal elements are identical to applicant's mark as to sound, and as to appearance, they are substantially the same as applicant's mark. Although opposer's design marks also contains a "PF" design, it is the PHASE FORWARD portion that is the dominant element of these marks, since consumers will call for opposer's goods and services using this term. See In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). Although we have compared the marks in their entireties, we have thus accorded greater weight to the PHASE FORWARD portion of opposer's registered marks. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) [in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing

improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests upon a consideration of the marks in their entirety].

However, despite the fact that the term PHASE FORWARD is the same in both marks, because of the goods and services with which the respective marks are used, they have connotative differences. With respect to opposer's goods and services, the term "phase" suggests a connection with FDA processes, such as "Phase II clinical trials." For applicant's mark, applicant's website shows a presentation topic known as "New Product Development - Phase 0: Ideation and Concept Generation." Accordingly, prospective customers are likely to view the word "phase" in opposer's mark as suggestive of a "phase" of clinical trials, while applicant's usage may be suggestive generally of a discrete piece of a consultation service project. Thus, while the parties' marks are identical in sound and nearly identical in appearance, because of the differences in connotation we cannot say that they convey the same commercial impression. See In re British Bulldog, Ltd., 224 USPQ 854 (TTAB 1984) [the mark PLAYERS has different connotations when applied to shoes and to men's underwear]. Thus, we do not think it appropriate under these circumstances to apply the general

principle that, when the marks in question are identical (or substantially so), their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

We turn next to the du Pont factor focusing on the similarities/dissimilarities of the goods and services. It is well settled that the registrability of applicant's mark must be evaluated on the basis of the recitation of services as set forth in the involved application, compared with the recitation of services and/or the identification of goods contained in the pleaded registrations of record. See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Additionally, absent any specific limitations in applicant's identification of goods and the identification of goods and recitation of services contained within opposer's registrations, the issue of likelihood of confusion must be determined by looking at all the usual channels of trade and methods of distribution for the respective services and

goods. See CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Opposer acknowledges that there are obvious differences between opposer's services and goods and applicant's services. Nonetheless, opposer argues that:

... it is clear that the goods and services are related and that the public will be confused as to the source of the goods or services from Applicant if she is allowed to use the mark for consultation and business planning services in and to the pharmaceutical, software and healthcare industries. Applicant's use of the mark will infringe upon related goods/services produced by Opposer. Applicant has marketed herself to pharmaceutical and software industries for assistance in the creation of wireless networks and has indicated plans to expand to related goods/services including consultation and assistance in the fields of electronic data capture. This electronic data capture software and related services are precisely the goods and services Opposer markets to the public.

Opposer's brief, pp. 16 - 17.

Opposer is correct in noting that goods and services need not be identical in order to support a finding of likelihood of confusion. On the other hand, opposer has the burden of proof in this proceeding to demonstrate a relatedness of the services and/or goods, as well as to show an overlap of customers and institutions.

Based on the limited record before us, we cannot determine exactly who opposer's customers are. Although by

the very identifications of opposer's goods and services, it is obvious that they are used in connection with clinical trials of pharmaceutical products, it is not clear whether these goods and services would be sold or offered to hospitals or other health care facilities, or whether they would be purchased only by pharmaceutical companies whose products are being tested, such that the entities actually carrying out the trials would not encounter opposer's mark. Thus, even though we must construe applicant's identified consultation services as encompassing consultation services rendered to those in the healthcare field (a supposition confirmed by the evidence showing that applicant is interested in teaming up with a consultancy firm to equip healthcare facilities with wireless infrastructures allowing for tasks such as electronic data capture (Adams Deposition, pp. 79 - 101)), we cannot find, based on this limited record, that there is an overlap between opposer's and applicant's customers. Moreover, even if we were to assume that opposer and applicant could offer their respective goods and services to healthcare facilities such as large research hospitals, we cannot determine, from this limited record, that the individual consumers within such large institutions would be the same. For example, pharmaceutical companies may purchase and then supply to those doctors

carrying out clinical tests the specific software that they purchase from opposer, while others in the administration area of the hospital would encounter applicant's consultation services. See Electronic Design & Sales v. Electronic Data Systems, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992) [The Court found no likelihood of confusion resulting from the contemporaneous use of applicant's mark E.D.S. and opposer's mark EDS despite the fact that "the two parties conduct business not only in the same fields but also with some of the same companies." 21 USPQ2d at 1391]; see also In re N.A.D. Inc., 754 F.2d 996, 224 USPQ 969, 971 (Fed. Cir. 1985). We cannot base a finding of relatedness of services and/or goods on mere speculation, and on this record, find that opposer has failed to show that opposer's goods and services and applicant's consultation services are related. Thus, this key du Pont factor favors applicant.

We turn then to the du Pont factor focusing on the conditions under which and buyers to whom sales are made. Given the respective recitations of services and identification of goods, by definition, opposer's services and goods and applicant's services are not purchased casually by ordinary consumers. Such purchasers, even if they were to encounter both parties' services and goods, are not likely to believe that all goods and services that are

offered in the healthcare area emanate from a single source simply because they are sold or rendered under the same mark. This du Pont factor clearly favors applicant.

Opposer has not submitted any evidence on the factor of the fame of opposer's marks or the factor of the variety of services and goods on which opposer's mark is used, and therefore we find these factors to be neutral.

In conclusion, although the parties have similar marks, we find, based on this record, that opposer has failed to prove that applicant's services are sufficiently related to opposer's goods and services that confusion is likely. When we consider all the du Pont factors on which there is evidence, we find that opposer has not shown by a preponderance of the evidence that confusion is likely. Accordingly, we dismiss the opposition on the ground of likelihood of confusion.

- **Dilution**

In addition to its claim of likelihood of confusion, opposer has also pressed a claim of dilution. The Federal Trademark Dilution Act (FTDA) provides a federal cause of action for the dilution of a famous mark, and the Trademark Amendments Act of 1999 (TAA) "requires the Board to consider

dilution under the FTDA as a ground for opposition."⁵ Toro Co. v. ToroHead Inc., 61 USPQ2d 1164 (TTAB 2001). To prevail on its dilution claim, opposer must establish, *inter alia*, that its mark is famous. Furthermore, establishing fame for dilution purposes is a more rigorous endeavor than establishing the renown of a mark for a Section 2(d) likelihood of confusion analysis. Toro, 61 USPQ2d at 1180-81. Accordingly, having found *supra* that opposer's PHASE FORWARD marks have not been shown to be well-known in the context of our likelihood of confusion analysis, and, in fact, that opposer submitted absolutely no evidence of fame, they are *ipso facto* not famous for purposes of dilution. Accordingly, we dismiss the opposition on the ground of dilution.

Decision: We dismiss the opposition on the grounds of likelihood of confusion and dilution.

⁵ The FTDA, 109 Stat. 985, is codified at Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), with dilution defined in Section 45, 15 U.S.C. §1127, and the TAA, 113 Stat. 218, is codified in various sections of Title 15 of the U.S. Code.